REMARKS

Formal Matters

Claims 34-39 remain in this application. Claim 34 is amended. Support for the amendment to claim 34 is found throughout the specification, such as at, for example, page 25, lines 9-12; page 46, line 10 to page 47, line 7; and in previously pending claims 22 and 34. No new matter is added by the amendments.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 34-39 are rejected under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement. Applicants respectfully traverse the rejection as applied and as it might be applied to the currently pending claims for the reasons provided below.

The Examiner states that the specification does not describe with particularity members of the genus of antibodies that bind to an epitope bound by the 8B8 antibody. Applicants respectfully disagree. The 8B8 antibody is deposited with the ATCC as hybridoma HB-12070. The claimed nucleic acid encodes an antibody that binds ErbB3 and blocks binding of the deposited 8B8 antibody to ErbB3. Further, the antibody reduces heregulin-induced formation of an ErbB2/ErbB3 complex in a cell which expresses ErbB2 and ErbB3. The genus of antibodies encoded by the claimed nucleic acid is defined functionally by the ability to bind ErbB3 and reduce heregulin-induced formation of an ErbB2/ErbB3 complex and structurally by its ability to bind the extracellular domain of ErbB3 and block binding of antibody 8B8, available from hybridoma HB-12070. One of ordinary skill in the art can readily determine the genus of antibodies by, for example, testing the functional feature of reduced ErbB2/ErbB3 complex formation in the presence of ErbB3 ECD-binding antibody as disclosed in the specification at page 48, lines 6-23, and by testing the structural feature by, for example, cross-blocking experiments disclosed in the specification at page 25, lines 9-12, using antibody 8B8 from the deposited hybridoma. Applicant provided evidence of an actual reduction to practice in the Example (see page 45, line 20 to page 51, line 22, and Figures 1-3). Antibodies are prepared which bind the ECD of ErbB3 and are shown to reduce formation of an ErbB2-ErbB3 complex.

Preparation and testing of such antibodies according to Applicants' disclosure and obtaining a nucleic acid encoding the antibody is readily and routinely performed by one of ordinary skill in the art without undue experimentation.

Applicants submit that the rejection under 35 USC § 112, first paragraph has been overcome and the claims are in condition for allowance. Withdrawal of the rejection and allowance of the claims is respectfully requested.

SUMMARY

Claims 34-39 are pending in the application. Claim 34 is amended without the addition of new matter. The rejection under 35 USC § 112, first paragraph has been overcome. Withdrawal of the rejection and allowance of the claims is respectfully requested.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a three-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

GENENTECH, INC.

Date: May 8, 2006

By

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